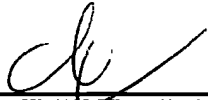




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/720,909

11/24/2003

Roland Janzen

DCS-9151

5291

34500

7590

05/17/2006

DADE BEHRING INC.
LEGAL DEPARTMENT
1717 DEERFIELD ROAD
DEERFIELD, IL 60015

EXAMINER

VENCI, DAVID J

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/720,909	Applicant(s) JANZEN ET AL.	
	Examiner David J. Venci	Art Unit 1641	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED March 27, 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on April 11, 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 1-8, 12 and 14-16.
Claim(s) withdrawn from consideration: 9-11 and 17-21.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____


LONG V. LE 05/12/06
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Continuation of 11:

Claims 1-8, 12 and 14-16 are product claims. Claims 1-8, 12 and 14-16 are not method claims. Accordingly, in claim 1, the recited claim language "dissociated" first binding species is interpreted as a statement that merely states an intended use or intended result of the claimed product invention. Similarly, the recited claim language of binding partners capable of selectively binding "dissociated" first binding species is interpreted as a statement that merely states an intended use or intended result of the claimed product invention. In addition, the recited claim language of binding "dissociated" first binding species without detrimentally affecting the signal strength of said assay is not afforded patentable weight because the claim language is interpreted as a statement that merely states an intended use or intended result of the claimed product invention.

The intended use of the claimed product invention must result in a structural difference between the claimed product invention and the prior art in order to patentably distinguish the claimed product invention from the prior art. If the prior art structure is capable of performing the intended use or intended result, then the prior art meets the claim.

Here, the prior art teachings of Ullman et al. describe a product wherein a "binding partner" binds to a "binding species" (see col. 35, lines 36-38; col. 37, lines 28-35).

Applicants' reliance on "lines 33-34" of Ullman et al., which allegedly states that "preferably the photosensitizer and chemiluminescent molecules are incorporated into particles and the sbp (specific binding partner) members are attached to the particles" (see Applicants' AMENDMENT AFTER FINAL, paragraph bridging pp. 3-4, second sentence) does not appear to address the passages in Ullman et al. that were cited in the prior Office Action, and its relevance to the instant rejection is not clear.

Applicants' reliance on an allegedly analogous situation of an "antibody specific to hCG" versus an "antibody specific to cyclosporine" is not clear. Examiner requests that Applicants further expound this analogy.